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CASE LA0050 NP

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Burton Rodney
Type or print name

Burton Rodney
Signature

June 22, 2004
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

ROBL ET AL.

PATENT NO.: 6,395,767

ISSUED: MAY 28, 2002

FOR: CYCLOPROPYL-FUSED PYRROLIDINE-BASED INHIBITORS OF
DIPEPTIDYL PEPTIDASE IV AND METHOD

Certificate

JUN 29 2004

of Correction

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTENTION: Decision and Certificate of Correction
Branch of Patent Issue Division

REQUEST FOR CERTIFICATE OF CORRECTION OF PATENT

FOR PTO MISTAKE (37 C.F.R. §1.322(a))

Sir:

Attached, in duplicate, is PTO/SB/44 (also Form PTO-1050), with at least one copy being suitable for printing.

The exact page and line number where the errors are shown correctly in the application file are:

Claim 8 should read: --A compound having the structure:--.

Claim 10 should read: --A compound which is--.

This correction is necessary because of an error by the Office as follows.

Applicants filed an AMENDMENT UNDER 37 CFR 1.312 (copy enclosed) wherein Claim 8 is amended to place it in independent form and Claim 10 is amended to place it in independent form.

29 JUN 2004

The Examiner in his Response to Rule 312 Communication (PTO-271 (Rev. 04-01)) (copy enclosed) indicated on page 2 that:

☒ 1. The amendment filed on 1/2/02 under 37 CFR 1.312 has been considered, and has been . . .

b). ☒ entered as directed to matters of form not affecting the scope of the invention."

The subject U.S. Patent No. 6,395,767 issued with Claim 8 and Claim 10 each being dependent on Claim 1, and without including Claim 8 and Claim 10 each being in independent form.

It is respectfully submitted that the Patent Office erred in not including Claim 8 and Claim 10 in independent form since the Examiner had entered Applicants' Amendment Under 37 CFR 1.312 to matters not affecting scope of the invention. Changing Claims 8 and 10 from dependent claims to independent claims does not change the scope of either Claim 8 or Claim 10. Either way, independent Claims 8 and 10 only cover the compounds in dependent Claims 8 and 10.

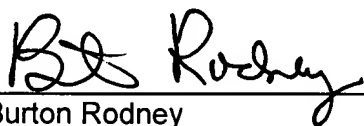
Accordingly, it is respectfully requested that the attached Certificate of Correction be approved and be included as part of the subject U.S. Patent No. 6,395,767.

Inasmuch as that this error was incurred by the Office, no fee is believed to be due. If any fee not accounted for is due in connection herewith, please charge such fee to Deposit Account No. 19-3880 of the undersigned.

Please send the Certificate to the address associated with customer account number 23914.

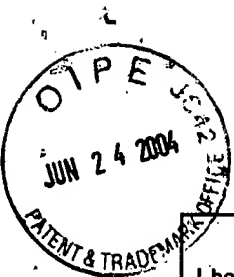
Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(609) 252-4336



Burton Rodney
Attorney for Applicants
Reg. No. 22,076

Date: June 22, 2004



CASE LA0050 NP

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Burton Rodney
Type or print name

Signature

Date

Nov. 14, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

"B"

IN RE APPLICATION OF

Art Unit: 1626

ROBL ET AL.

Examiner: R. Gerstl

APPLICATION NO: 09/788,173

FILED: FEBRUARY 16, 2001

FOR: CYCLOPROPYL-FUSED PYRROLIDINE-BASED INHIBITORS OF
DIPEPTIDYL PEPTIDASE IV AND METHOD

Assistant Commissioner for Patents
Box Issue Fee
Washington, D.C. 20231

AMENDMENT UNDER 37 CFR 1.312

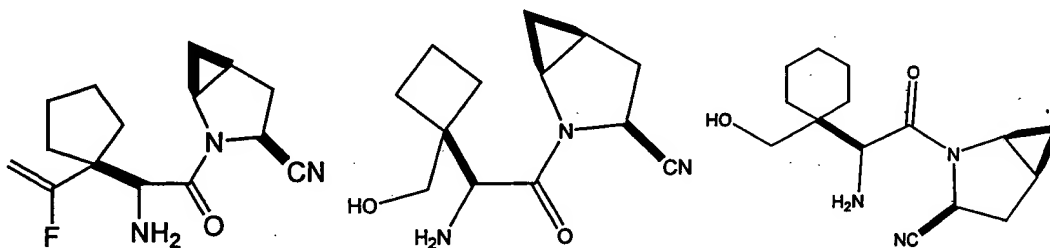
Sir:

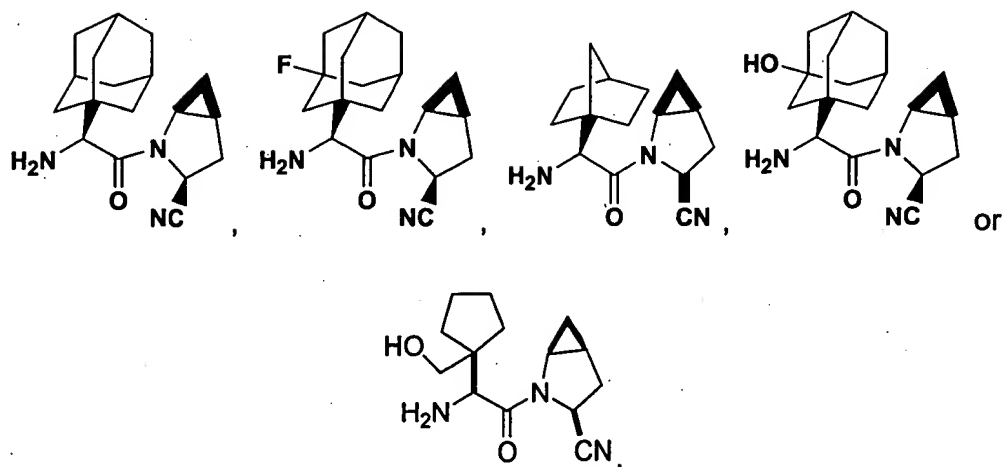
Please amend the above-identified application to read as follows:

In the Claims:

Please amend Claims 8 and 10 to read as follows:

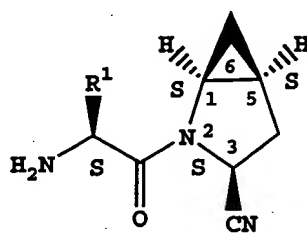
8. (Amended) A compound having the structure:





or a pharmaceutically acceptable salt thereof.

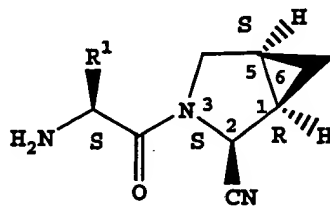
10. (Amended) A compound which is



A

(1S,2(2S),3S,5S)

wherein R^1 is alkyl, cycloalkyl, bicycloalkyl, tricycloalkyl, alkylcycloalkyl, hydroxyalkyl, hydroxycycloalkyl, hydroxyalkylcycloalkyl, hydroxybicycloalkyl, or hydroxytricycloalkyl,
or



B

(1R,2S,3(2S),5S)

wherein R^1 is alkyl, cycloalkyl, bicycloalkyl, tricycloalkyl, alkylcycloalkyl, hydroxyalkyl, hydroxycycloalkyl, hydroxyalkylcycloalkyl, hydroxybicycloalkyl, or hydroxytricycloalkyl.

Remarks

Claims 1 to 24 are present and have been allowed in the Notice of Allowance mailed October 19, 2001.

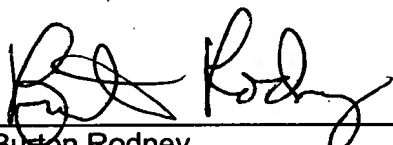
As seen above, Claims 8 and 10 have been amended to place each in independent form. No new matter has been added.

It is respectfully requested that the above amendments be entered.

A copy of Claims 8 and 10 with markings to show changes made is attached.

It is believed that this application is now in condition for issuance once the final fee has been paid.

Respectfully submitted,



Burton Rodney
Attorney for Applicants
Reg. No. 22,076

Bristol-Myers Squibb Company
Patent Department
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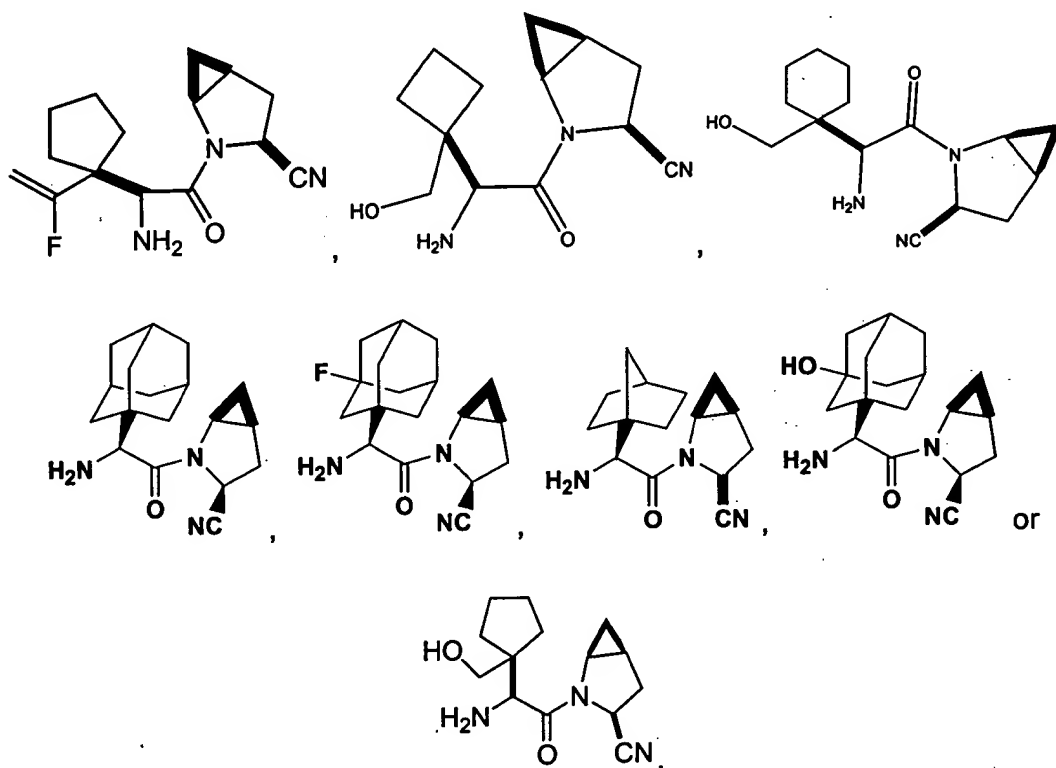
Date: Nov. 14, 2001

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

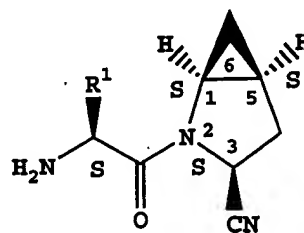
Claims 8 and 10 have been amended as follows:

-- 8. (Amended) [The] A compound [as defined in Claim 1] having the structure:



or a pharmaceutically acceptable salt thereof.--

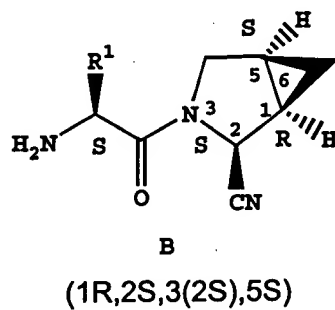
--10. (Amended) [The] A compound [as defined in Claim 1] which is



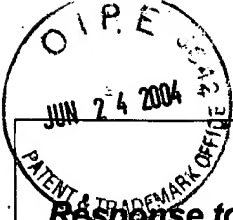
A

(1S,2(2S),3S,5S)

wherein R¹ is alkyl, cycloalkyl, bicycloalkyl, tricycloalkyl, alkylcycloalkyl, hydroxyalkyl, hydroxycycloalkyl, hydroxyalkylcycloalkyl, hydroxybicycloalkyl, or hydroxytricycloalkyl,
or



wherein R¹ is alkyl, cycloalkyl, bicycloalkyl, tricycloalkyl, alkylcycloalkyl, hydroxyalkyl, hydroxycycloalkyl, hydroxyalkylcycloalkyl, hydroxybicycloalkyl, or hydroxytricycloalkyl. —



Response to Rule 312 Communication

Application No.

09/788,173

Applicant(s)

ROBL ET AL.

Examiner

Robert Gerstl

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The amendment filed on 12/20/01 under 37 CFR 1.312 has been considered, and has been:

a) ☐ entered.

b) ☒ entered as directed to matters of form not affecting the scope of the invention.

c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

d) ☐ disapproved. See explanation below.

e) ☐ entered in part. See explanation below.

Robert Gerstl
Primary Examiner
Art Unit: 1626

29 JUN 2004